

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROGER COLLINS and JOHN LAWRENCE FRIEND

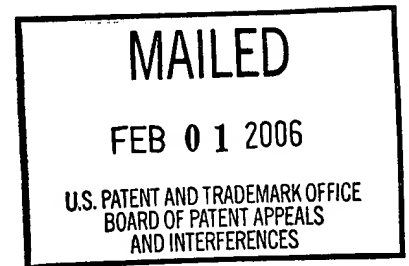
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Appeal No. 2006-0170  
Application No. 09/902,060

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ON BRIEF

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Before RUGGIERO, GROSS and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 3-9, 11, 13-19, 21, and 24-30.

The claimed invention relates to a method and system for compressing a current electronic mail message in which a block of data within the current electronic mail message that is found in a previous electronic mail message is identified. A pointer which identifies the block of data in the previous message is

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generated and the identified block of data in the current message is replaced with the pointer.

Claim 1 is illustrative of the invention and reads as follows:

Claim 1. A method for compressing an electronic mail message comprising:

identifying a block of data within said electronic mail message which is found in a previous electronic mail message;

generating a pointer identifying said block of data in said previous electronic mail message;

replacing said block of data in said electronic mail message with said pointer, and transmitting said electronic mail message to a wireless data processing device having said previous electronic mail message stored thereon.

The Examiner relies on the following prior art:

Szlam et al. (Szlam)            EP 0 806 858 A2            Nov. 12, 1997<sup>1</sup>  
(Published European Patent Application)

Claims 1-3, 11, 13, 21, and 24 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Szlam. Claims 4-9, 14-19, and 25-30 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Appellants' admitted prior art in view

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<sup>1</sup>In addition, the Examiner relies upon Appellants' admissions as to the prior art in the specification.

of Szlam.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed July 19, 2004) and Answer (Supplemental, mailed August 16, 2005) for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Szlam reference does not fully meet the invention as set forth in claims 1, 3, 11, 13, 21, and 24. With respect to the Examiner's 35 U.S.C. § 103(a) rejection, we are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as recited in claims 4-9, 14-19, and 25-30. Accordingly, we reverse.

We consider first the rejection of claims 1, 3, 11, 13, 21, and 24 under 35 U.S.C. § 102(b) as being anticipated by Szlam. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to the appealed independent claims 1, 11, and 21, the Examiner attempts to read the various limitations on the disclosure of Szlam. In particular, the Examiner (Answer, pages 3, 5, and 6) points to various portions of Szlam at columns 5, 6, 14, 15, 24, and 28.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Szlam so as to establish a case of anticipation. Appellants' arguments (Brief, pages 6-9) primarily focus on the contention that, in contrast to the claimed invention, Szlam does not disclose the identification of a previous electronic mail

message which contains a block of data found in a new electronic mail message. In Appellants' view (id., at 8), Szlam merely discloses the creation of a composite object upon receiving a transaction, which may be an e-mail transaction, but never discloses the particular contents of any such e-mails, nor any relationship between two or more e-mails.

After reviewing the Szlam reference in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief. In particular, we agree with Appellants that Szlam, at best, discloses the cumulative collection of previous communications which may include the use of pointers to an information data base. While we agree with the Examiner that the use of pointers permits the amount of data that is required to be transmitted to be compressed, the language of independent claims 1, 11, and 21, in our view, requires more. Specifically, as asserted by Appellants (Brief, pages 8 and 9), each of the claims 1, 11, and 21 requires the identification in an e-mail message of a block of data that is found in a previous e-mail message, and the replacement of such block of data with a pointer identifying such block of data in the previous e-mail message. Our interpretation of the disclosure of Szlam coincides with that of Appellants, i.e., we find no disclosure in Szlam of

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any analysis of communications to determine and identify blocks of data which may have appeared in previous communications, and consequently, no disclosure of the replacement of such identified blocks of data with pointers as claimed.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 4-9, 14-19, and 25-30 based on the combination of Szlam and Appellants' admitted prior art, we do not sustain this rejection as well. The admitted prior art has been added to Szlam by the Examiner to address the particular data compression techniques set forth in the rejected dependent claims. We find nothing, however, in the disclosure of the admitted prior art which would overcome the innate deficiencies of Szlam discussed supra.



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